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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,098

10/02/2003

Akira Higuchi

XA-9941

8393

181

7590

11/15/2005

MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

TRAN, DUE NGOC

ART UNIT

PAPER NUMBER

2841

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/676,098	Applicant(s) HIGUCHI ET AL.	
	Examiner Due N. Tran	Art Unit 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/02/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: in line 16, the word "terminal" is missing an "e". Appropriate correction is required.
2. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In claim 7 line 13, the applicant recites the limitation of a card adapter comprising "a resistor", however, claim 12 stated that the card adapter including "none of said resistor". Accordingly, the limitation "none of said resistor" in claim 12 fails to further limit the subject matter of a previous claim 7 and has not been further treated on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun et al (US 6,663,007) in view of Niwata (US 6,193,162).
4. With respect to claim 7, Sun discloses a card adapter having an interior space which fits the profile of an IC card of a first standard and having a profile of an IC card of

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a second standard, said adapter comprising: a plurality of first external terminals (see examiner's figure on page 6); a plurality of internal terminals (see examiner's figure on page 6) which are disposed at positions to be in contact with a plurality of second external terminals of an IC card (see examiner's figure on page 6) of the first standard when said IC card is set in said adapter interior space; wiring lines which connect between said first external terminals and said internal terminals (see examiner's figure on page 6); however, Sun does not disclose expressly wherein a resistor which is connected between a first external terminal, with a supply voltage or ground voltage being applied thereto, among said first external terminals and an internal.

The Niwata reference, however, discloses a resistor between a first external terminal, with a supply voltage or ground voltage being applied thereto, among said first external terminals and an internal (Fig. 18(a), 18(b) element R).

Sun and Niwata are analogous art because they are from the same field of endeavor (Card adapter).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a resistor which is connected between a first external terminal and internal, with a supply voltage or ground voltage being applied thereto to the IC adapter of Sun

The suggestion or motivation for doing so would have been obvious in view of teaching of Niwata by adding a resistor to pull-up voltage and is useful in card insertion and removal detection.

Therefore, it would have been obvious to combine Niwata with Sun for the benefit of being able to detect the insertion and removal of the card.

5. With respect to claim 8, Niwata discloses the card adapter having a mechanically operated switch which is connected between the first external terminal, with said resistor being connected thereto, and another first external terminal (Fig. 27(a), (b), (c) element 271).

The suggestion or motivation for doing so would have been obvious in view of teaching of Niwata in col. 11 lines 11-14 that the switch is used in recognizing whether the adapter is of single density or double density and establish communication between them accordingly.

6. With respect to claim 9, Sun discloses the card adapter wherein said internal terminals have a generally laid out to have their rectangular profile in plan and are long side extending along the card insertion direction of the first standard (see examiner's figure on page 6).

7. With respect to claim 10, Sun discloses the card adapter wherein said internal terminals are formed to swell in the cross section taken along the card insertion direction of the first standard (Fig. 5).

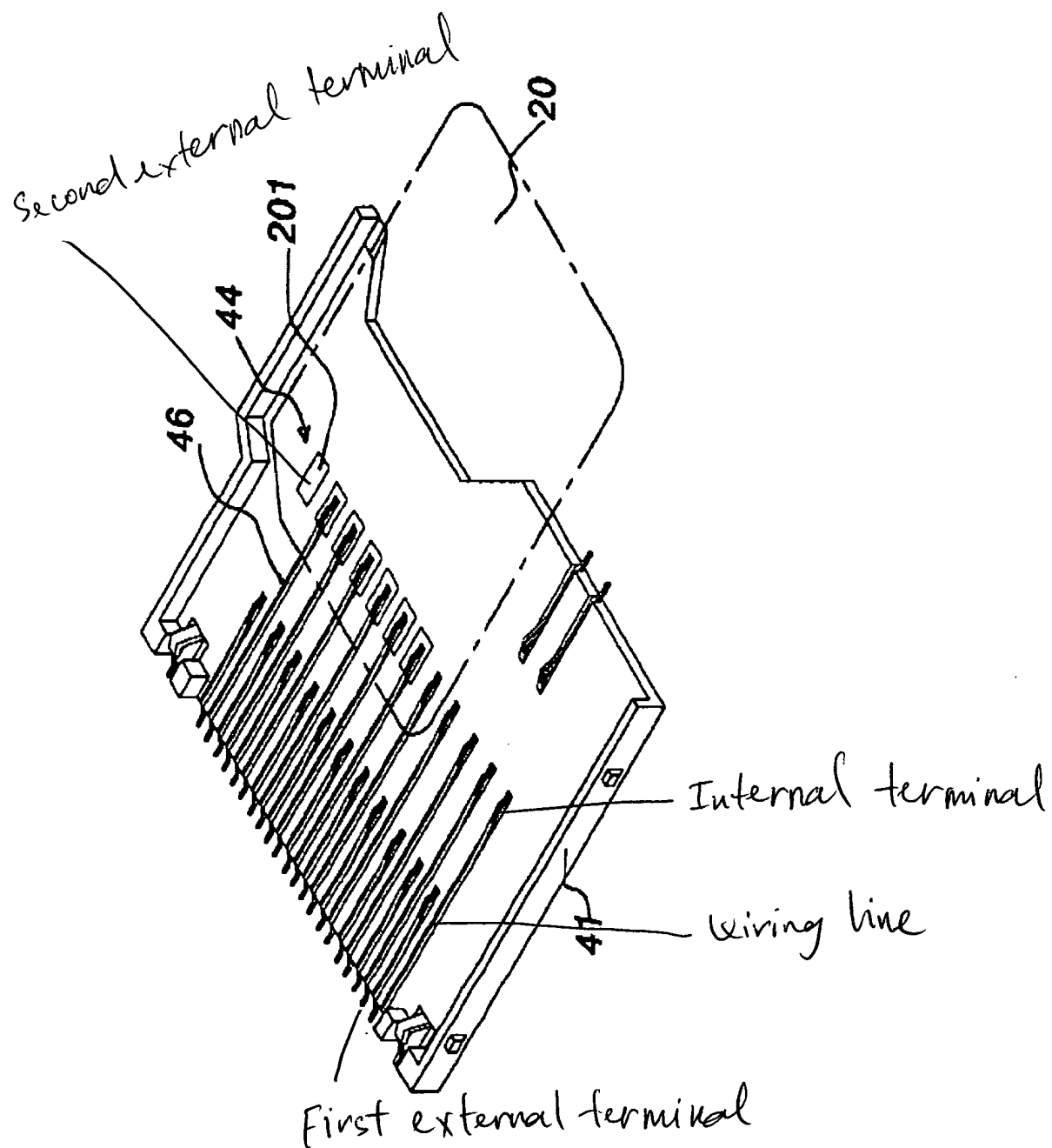
8. With respect to claim 11, Sun discloses the card adapter having no semiconductor chip connected between said first external terminal and said internal terminal.

9. With respect to claim 12, Niwata discloses the card adapter including a semiconductor chip connected between said first external terminal and said internal

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terminal, said semiconductor chip having no formation of a circuit which is used for the writing and reading of an IC card of the second standard (Fig. 27(a) element 181).

10. With respect to claim 13, Sun discloses the card adapter 1 wherein said first standard is the multimedia card standard and said second standard is the memory stick standard (page 18, col. 1 lines 7-11).



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Due N. Tran whose telephone number is (571) 272-5984. The examiner can normally be reached on Monday-Thursday, 9:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DT


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